



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/722,962 | 11/27/2000 | Larry A. Greenspan | 08563-0087 | 5141 |
| 23370 | 7590 | 09/24/2004 | EXAMINER | |
| JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309 | | | PORTER, RACHEL L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,962

Applicant(s)

GREENSPAN ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 6/28/04.

Claims 1-60 have been cancelled. Claims 61-92 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 6/28/04 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 61-75 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Art Unit: 3626

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case of claim 61, the recited steps of merely obtaining information about a dental procedure and inputting that information into a template does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

As to technological arts recited in the step storing the dental presentation in a desktop application, mere recitation or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into a processing or analysis step within the claim. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation of storing the presentation on a desktop application. Looking at the claim as a whole, nothing the body of the claim

Art Unit: 3626

recites any structure or functionality to suggest that a computer performs the recited processing or analysis steps.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 61 is deemed to be directed to non-statutory subject matter.

Claims 62-75 inherit the deficiencies of claim 61 through dependency, and are also rejected.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 75 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear to the Examiner which statutory class of invention the Applicant intends to claim in the present claim and how a method can be embodied on a computer readable medium. In other words it is unclear if the Applicant truly intends to claim the method or if the applicant intends to claim a computer readable medium storing instructions which when executed by a computer processor cause the processor to perform certain steps (i.e. the steps performed in claim 61). It should be noted that when properly claimed, the

Art Unit: 3626

corresponding computer readable medium would be interpreted as an "article of manufacture," not a method, and could not be dependent from another claim in a separate statutory class.

Insofar as the Sachdeva and Clark references are computer implemented, the Examiner will interpret the prior art as addressing the limitations in claim 75

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 61-63 and 66-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva (USPN 6,587,828) in view of Clark et al (USPN 6,171,112).

[claims 61 and 69] Sachdeva teaches a method for generating and tracking presentations for a dental patient describing a recommended course of dental treatment comprising of at least one dental procedure, the method comprising the steps of:

a. forming at least one template configured for display as a dental presentation template, wherein the dental presentation template comprises at least one specific dental procedure indicator for use as a point of incorporation

Art Unit: 3626

for specific dental information on the recommended course of treatment; (col. 3, lines 4-col. 4, line 8; col. 4, lines 24-38)

b. inserting in each template at least one general information indicator for use as a point of incorporation for general information on the dental patient; (col. 4, lines 9-65)

c. incorporating specific dental information about the specific dental procedure from the recommended course of treatment for the dental patient into the template; (col. 4, lines 9-48; col. 5, lines 49-col. 6, line 15)

d. incorporating the general information on the dental patient into at least one template; (col. 4, lines 9-48; col. 5, lines 49-col. 6, line 15)

e. generating a dental presentation using at least one template with the incorporated specific dental information and the general information on the dental patient with one step; (col. 5, lines 32-col. 6, lines 15)

f. storing the dental presentation in a dental desktop application; (col. 3, lines 58-col. 4, line 8)

g. presenting the dental presentation to the dental patient; and (col. 4, lines 24-27: displaying treatment plan; col. 6, lines 3-33—patient acknowledges simulated treatment results)

Sachdeva discloses a method as explained above, and further disclose that the dental presentation is provided to the patient to acknowledge information in the presentation. (col. 6, lines 3-33). However, Sachdeva does not expressly disclose a method in which the day and time that the dental presentation was patient is recorded. Clark teaches system and method for informed patient t

Art Unit: 3626

consent wherein the time and date of when the presentation is given to the patient is recorded. (Figure 26; col. 25, line 61-col. 26, line 26, line 5) At the time of the Applicant's invention, it would have been obvious to one ordinary skill in the art to modify the method of Sachdeva with the teaching of Clark to record time and data when the presentation is given to the dental patient. As suggested by Clark, one would have been motivated to include this feature to enhance the quality of the patient-healthcare provider experience prior to medical procedures by presenting information to a recipient while confirming receipt and comprehension of the information by the patient (col. 3, lines 45-49)

[claim 62] See Sachdeva (col. 3, lines 55-col. 4, line 43)

[claim 63] Sachdeva teaches a method further comprising the step of editing the dental presentation to add additional dental procedures. (col. 7, lines 37-56)

[claim 66] Sachdeva teaches a method of claim 61, further comprising the steps of:

- generating a list of recommended dental procedures for the dental patient, wherein the recommended dental procedures are previously entered into the dental desktop application as being recommended for the dental patient; and (col. 4, lines 27-38)
- selecting at least one recommended dental procedure from the list of recommended dental procedures for inclusion in the recommended course of treatment. (col. 4, lines 27-65; col. 5, lines 11-48)

[claim 67] Sachdeva teaches a method further comprising the step of using the dental desktop application to select automatically all recommended dental procedures in the list of recommended dental procedures for inclusion in the recommended course of treatment. (col. 5, lines 11-48)

[claim 68] Sachdeva teaches a method further comprising the step of editing the list of recommended dental procedures to include the dental procedure for the dental patient. (col. 7, lines 20-36; col. 8, lines 33-57)

[claim 70] Sachdeva teaches a method further comprising the step of incorporating the dental procedure into the template includes for each dental procedure, the steps of:

- retrieving a procedure information file for the dental procedure, wherein the procedure information file includes a plurality of details related to the dental procedure including a member of the group comprising: test data, time for the procedure, medications for the procedure, post procedure follow up and combinations thereof; and (col. 4, lines 9-32; col. 6, lines 3-14)
- inserting the procedure information file into the dental template. (col. 4, lines 9-32; col. 6, lines 3-14)

[claim 71] Sachdeva teaches a method further comprising the step of editing the procedure information file prior to inserting the procedure information file into the dental template. (col. 7, lines 20-36; col. 8, lines 33-57)

Art Unit: 3626

[claim 72] As per the limitations of claim 72, see Sachdeva: col. 3, lines 36-col.4, line 38; Figure 1(labeled sections identify where information is intended to go)

[claim 73] Sachdeva teaches a method, wherein the step of storing the dental presentation in the dental desktop application includes the step of integrating the dental presentation into dental desktop application records for the dental patient. (col. 3, lines 36-col.4, line 23; col. 4, line 49-67— patient's treatment plan generated, stored and accessible to a plurality of parties)

[claim 74] Sachdeva teaches a method further comprising the steps of:

- indicating at least one dental procedure of the recommended course of treatment was accepted by the dental patient; and (col. 6, lines 3-43)
- updating records of the dental desktop application records for the dental patient to correspond to the indicated accepted dental procedure. (col. 6, lines 3-43)

[claim 75] See the 112, 2nd rejection of claim 75 and the citations for claim 61 above.

8. Claims 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva (USPN 6,587,828) and Clark in view of Parker (Microsoft Office 4 for Windows for Dummies)

[claim 64] Sachdeva and Clark teach the method of claim 63, as explained in the rejection of claim 63 above, but do not expressly disclose the use of plug-in tool bars for editing or exchanging information among applications for a dental

Art Unit: 3626

presentation. Parker discloses the use of plug-in tool bars to edit presentations and to exchange information among applications (pp. 184, 195-200: eg. Clip art/ spell check/ word toolbars). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Sachdeva and Clark in combination, with the teaching of Parker to include the use of plug-in tool bars to edit presentations and to exchange data among applications. As suggested by Parker, one would have been motivated to include these features to facilitate navigation through a presentation and to enhance the visual impact of the presentation. (page. 195)

[claim 65] Sachdeva teaches a method wherein said step of editing the dental presentation comprises at least one of the steps of adding other information to the dental presentation, removing information from the dental presentation and changing information in the dental presentation. (col. 7, lines 20-36; col. 8, lines 33-57)

9. Claims 76-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachdeva (USPN 6,587,828) in view of Parker (Microsoft Office 4 for Windows for Dummies)

[claims 76 and 80] Sachdeva teaches a system for generating and displaying a dental presentation describing a recommended course of treatment having at least one dental procedure for a dental patient, the system comprising:

a. at least one computer, wherein said at least one computer comprises at least one memory device, a dental desktop application stored in said at least one

Art Unit: 3626

memory device, and a presentation tool stored in said at least one memory device; (col. 3, lines 36-col. 4, line 38)

b. one step selection, merger and storage application for selecting a template for a dental presentation, (col. 4, lines 9-48; col. 5, lines 49-col. 6, line 15) and wherein said dental presentation is stored in said at least one memory device; (col. 3, lines 55- col. 4, lines 8)

c. a presentation tool for presenting said dental presentation to said dental patient; and (col. 4, lines 24-27: displaying treatment plan)

d. a tracking tool, wherein when at least one dental procedure of said recommended course of treatment is accepted by a dental patient the patient records in the dental desktop application correspond to the accepted dental procedure. (col. 4, lines 24-27: displaying treatment plan; col. 6, lines 3-33—patient acknowledges simulated treatment results)

Sachdeva discloses the use of templates for creating the medical and dental presentations for patients as explained above, but does not expressly discuss the use of slides as part of the user presentation. Parker discloses that Microsoft PowerPoint allows users incorporate slides as part of a customized visual presentation. (Parker: pages 187-197) Microsoft PowerPoint also allows information to be automatically incorporated into the slide presentation. (Parker: pages 195-198) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Sachdeva with the teaching of Parker to include slides with information that has been automatically incorporated as part of a customized patient presentation. One

Art Unit: 3626

would have been motivated to do this to improve or increase the visual impact of the presentation and to provide a quick and efficient way for a user to review and/or reformat the final presentation. (Parker: page. 195)

[claim 77] Sachdeva teaches a system wherein the selection, merger, and storage application in a single action further incorporates general patient information into the dental presentation. (col. 3, lines 55-col. 4, line 43)

[claim 78] See Sachdeva: Figures 1-3; col. 3, lines 36-col. 4, line 65; col. 6, lines 43-46.

[claims 79 and 84-85] Sachdeva and Parker teach the system of claim 76, as explained in the rejection of claim 76 above. Sachdeva does not expressly disclose the use of plug-in tool bars for editing or exchanging information among applications for a dental presentation. Parker discloses the use of plug-in tool bars to edit presentations and to exchange information among applications (pp. 184, 195-200: e.g. Clip art/ spell check/ word toolbars). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Sachdeva, with the teaching of Parker to include the use of plug-in tool bars to edit presentations and to exchange data among applications. As suggested by Parker, one would have been motivated to include these features to facilitate navigation through a presentation and to enhance the visual impact of the presentation. (page 195)

[claims 81-82] See Sachdeva: Figures 1-3; col. 4, lines 24-col. 6, line 15

[claims 83] Sachdeva and Parker teach the system of claim 76, as explained in the rejection of claim 76. Sachdeva discloses creating a dental presentation, but

Art Unit: 3626

does not expressly disclose the use of slides and therefore, does not disclose a system further comprising an indicator configured to indicate a point of incorporation for at least one slide. Parker discloses a system for incorporating slides into a presentation (i.e. an indicator configured to indicate a point of incorporation for at least one slide) (pages 171-173). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Sachdeva with the teaching of Parker to include an indicator to indicate a point or incorporation for a slide having specific dental information on at least one dental procedure included in a recommended course of treatment. As suggested by Parker, one would have been motivated to include this feature to facilitate navigation through a presentation and to enhance the visual impact of the presentation. (page 195)

[claims 86-87] See Sachdeva: col. 4, lines 9-38, 49-65; col. 5, lines 11-col. 6, line 15; col. 6, lines 43-46

[claim 88] See Sachdeva: col. 3, lines 36-col.4, line 38; Figure 1(labeled sections identify where information is intended to go)

[claim 89] Sachdeva teaches a system wherein the dental presentation stored in the at least one memory device comprises an integrator for integrating said dental presentation into dental desktop application records for said dental patient. (col. 3, lines 36-col.4, line 23; col. 4, line 49-67— patient's treatment plan generated, stored and accessible to a plurality of parties)

Art Unit: 3626

[claim 90] Sachdeva teaches a system wherein said dental presentation incorporates information from a dental database on a list of services offered by said dental practice (col. 4, lines 24, lines 27-35; col. 5, lines 11-31)

[claims 91-92] See (col. 4, lines 9-23; col. 5, lines 32-48)

Response to Arguments

10. Applicant's arguments with respect to claims 61-92 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Bodick et al discloses a system and method for customizing and formatting medical presentations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP
RP**ALEXANDER KALINOWSKI**
PRIMARY EXAMINER